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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,372	01/03/2002	Akimoto Masao	P21380	8656

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EXAMINER
JOO, JOSHUA

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/034,372	MASAO ET AL.
	Examiner	Art Unit	
	Joshua Joo	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 September 2006*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7-12* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Detailed Action

1.   Claims 7-12 are presented for examination.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR

1.17(e), was filed in this application after final rejection. Since this application is eligible for continued

examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the

finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's

submission filed on 9/5/2006 has been entered.

Response to Arguments

3.   Applicant's arguments filed 9/5/2006 have been fully considered but they are not persuasive.

Applicant argued that:

4.   (1) Chen does not utilize URL data to transmit the e-mail message to the e-mail recipient.

5.   In response, Chen teaches of a front end device requesting the email message to be sent, and if the

front end device is implemented in a web browser that displays pages, the email message is converted to

an appropriate format (Col 2, lines 26-36). The converted HTML email is sent to the front end device

based on a command, and although the front end device utilizes a web browser, Chen does not explicitly

teach that the converted HTML email is sent based on an URL.   Beer teaches of converting an email

address into URL, and using the converted URL to retrieve objects on the network (Col 3, lines 26-34;

Col 4, lines 10-31). It would have been obvious to one of ordinary skill in the art at the time the invention

was made to combine the teachings of Chen and Beer to transmitted the converted HTML email based on

the URL because doing so would improve the teachings of Chen by allowing users to request web pages,

i.e. HTML data, through the web browser, and allowing an user to access the user's private information

on a public network (Abstract).

6.   (2) Toyoda fails to disclose at least a communication control apparatus which includes at least (1)

a controller that converts the e-mail address of the recipient into URL data, and (2) a controller that

transmits to the recipient, via the first communicator, HTML data without receiving, from the recipient,

an instruction for the transmission of the HTML data to the recipient, based on the URL data according to

a HTTP protocol.

7.   In response to Applicant's argument that Toyoda fails to disclose certain features, one cannot

show nonobviousness by attacking references individually where the rejections are based on combinations

of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800

F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, it is noted that the features upon which applicant relies (i.e. a controller that

transmits to the recipient, via the first communicator, HTML data <u>without</u> receiving, from the recipient,

an instruction for the transmission of the HTML data to the recipient, based on the URL data according to

a HTTP protocol) are not recited in the rejected claim(s). Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8.   (3) Beer does not contain (or suggest) any disclosure with respect to an Internet facsimile

apparatus. Further, Beer discloses that a user at the receiving side must take an affirmative action. On the

other hand, a communication control apparatus of the present invention transmits to the recipient, via the

first communicator, the converted HTML data, based on the URL data when the received e-mail data is

converted into HTML data.

9.   In response, regarding the argument Beer does not contain any disclosure with respect to an

Internet facsimile apparatus, one cannot show nonobviousness by attacking references individually where

the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871

(CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, Applicant's limitation of "transmitting to the recipient the converted HTML data

when the received e-mail data is converted into HTML data" does not indicate a lack of an affirmative

action by a user. The converted URL may be sent as a request since the URL is an identifier of a resource

on the network, e.g. HTML, which would result in the retrieval of HTML data. In other words, the

HTML is sent based on the URL.

10.   (4) Beer does not disclose a second communicator which is connected to a receiving Internet

facsimile apparatus since Beer does not contain any disclosure with respect to an Internet facsimile

apparatus. Further, Beer does not disclose a controller which receives, from the transmitter via the first

communicator, URL data according to a HTTP protocol. Further, Beer does not disclose a controller

which converts HTML data into an e-mail address of the receiving Internet facsimile apparatus.

In response, regarding Applicant's argument that Beer does not disclose a second communicator

which is connected to a receiving Internet facsimile apparatus, and does not contain any disclosure with

respect to an Internet facsimile apparatus, one cannot show nonobviousness by attacking references

individually where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986).

Furthermore, it is noted that the features upon which applicant relies (i.e. a controller which

converts HTML data into an e-mail address of the receiving Internet facsimile apparatus) are not recited

in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057

(Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

12.   Claims 7, 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen, US

Patent #6,836,792 (Chen hereinafter), in view of Toyoda et al, US Patent #5,881,233 (Toyota hereinafter),

Beer et al, US Patent #5,864,676 (Beer hereinafter).

13.   As per claims 7 and 11, Chen teaches substantially the invention as claimed including the method

and apparatus for converting and transmitting messages across a network, Chen's teachings comprising:

        a first communicator configured to be connected to a network, the first communicator being a

component of the communication control apparatus (Col 2, lines 27-30. HTML accessed by the recipient.

First communicator is inherent since the system is able transmit the HTML to the recipient.);

        a second communicator configured to be connected to an apparatus, the apparatus transmitting, to

a recipient via the communication control apparatus, an e-mail, the second communicator being a

component of the communication control apparatus (Col 2, lines 1-2. Receives email from sender.

Second communicator is inherent since the system is able to receive email.); and

        a controller configured to:

receive, from the apparatus via the second communicator, an e-mail address of the recipient

according to a SMTP protocol (Col 1, lines 59-61. Composed email message includes email address. Col

2, lines 1-2. Email system receives email message. Col 2, line 10. SMTP.);

receive, from the apparatus via the second communicator, e-mail data directed to the recipient according

to the SMTP protocol (Col 1, lines 59-61. Composed email message includes email address. Col 2, lines

1-2. Email system receives email message. Col 2, line 10. SMTP.);

convert the received e-mail data into HTML data (Col 2, lines 30-35. Convert email message to

HTML.); and

transmit to the recipient, via the first communicator, the converted HTML data according to a

HTTP protocol (Col 2, lines 30-36. Send message to front end. Front end is implemented in a web

browser.).

14 .   Chen teaches substantial features of claims 7 and 11 including converting the email into HTML

data and transmitting the converted HTML data. However, Chen does not specifically teach of the

apparatus being an Internet facsimile apparatus transmitted email to which scanned image data is

attached; converting the email address of the recipient into URL data and transmitting the converted

HTML data based on the URL data according to a HTTP when the received e-mail data is converted into

the HTML data.

15.   Toyoda teaches of a facsimile apparatus capable of scanning image data and transmitting the

image data via email (Col 29, lines 19-33).

16.   It would have been obvious to one of ordinary skill in the art at the time the invention was made

to modify the teachings of Chen with the teachings of Toyoda because the teachings of Toyoda for a

facsimile apparatus to scan an image and to transmit an email would improve the capability of Chen's

system by allowing more than one type of apparatus to transmit email messages and receive HTML converted messages.

17.   Beer teaches of converting an email address into URL data (Col 4, lines 10-30), and using the converted URL to access objects on the network (Col 3, lines 27-31).

18.   Chen and Beer do not specifically teach of transmitting HTML based on the converted URL data. However, Chen teaches of requesting a command to receive HTML data from a device utilizing a web browser, and Beer teaches of receiving data on the network based on the converted URL. It would have been obvious to one of ordinary skill in the art to combine the teachings of Chen and Beer to receive the HTML data based on the URL and to convert the email address into URL data and to access HTML data based on the URL because doing so would improve the system of Chen and Toyoda by utilizing the web browser to retrieve and display HTML on the network and allowing an user to access the user's private information on a public network (Abstract).

19.   As per claim 8, Chen does not specifically teach the communication control apparatus according to claim 7, wherein the controller converts the e-mail address of the recipient into the URL data by converting an @ mark in the e-mail address of the recipient into a dot and adding HTTP:// at the beginning of the e-mail address of the recipient. Beer teaches of converting an email address to an URL, where the "@" is replaced with a dot and HTTP:// is added to the beginning of the converted email address (Col 4, lines 10-30).

20.   It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen, Toyota, Beer, and Higley because the teachings of Beer to convert an email address, where the "@" is replaced with a dot and HTTP:// is added to the beginning of the converted email address would improve the teachings of Chen by allowing the user to access converted

email by URL and by specifying the process of the conversion from email based protocol to a web based protocol. Beer's teachings also would allow users to access their converted email information on a public computer system with a web browser.

21.   Claims 9, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Britton, US Publication #2002/0177757 (Britton hereinafter), in view of Toyoda and Beer.

22.   As per claims 9 and 12, Britton teaches substantially the invention as claimed including the method and apparatus for converting and transmitting messages across a network, Britton's teachings comprising:

a first communicator configured to be connected to a network (Paragraph 0053; 0063. Receives HTML data. First communicator is inherent since the controller is able to receive HTML data from the web.);

a second communicator configured to be connected to a receiving apparatus, the receiving apparatus receiving, from a transmitter via the communication control apparatus, an e-mail (Paragraph 0053; 0063. Transmits email to the device. Second communicator is inherent since the controller is able to transmit to the device.); and

a controller configured to:

receive, from the transmitter via the first communicator, HTML data according to the HTTP protocol (Paragraph 0053; 0063. Receive HTML data.);

convert the received HTML data into e-mail data (Paragraph 0053; 0063. Convert HTML into email data.); and

transmit to the receiving apparatus, via the second communicator, the converted e-mail data, based on the e-mail address according to a SMTP protocol when the received HTML data is converted

into the e-mal data (Paragraph 0053; 0063. Transmits email message to the device. Controller forwards email data to the user.).

23.   Britton teaches substantial features of claims 9 and 12 including users accessing web sites to transmit HTML data. However, Britton does not specifically teach that the device is a facsimile apparatus; receiving an email to which the image data is attached and printing the image data to the received e-mail; receiving, from the transmitter via the first communicator, URL data according to a HTTP protocol; and converting the received URL data into an e-mail address of the receiving Internet facsimile apparatus.

24.   Toyoda teaches of facsimile apparatus that receives email, wherein a printer is integrated into the facsimile apparatus (Col 29, lines 19-25) that allows for printing image data (Col 32, lines 66-67).

25.   It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Britton with the teachings of Toyota because the teachings of Toyota for a facsimile apparatus to receive email data and to print the image data would improve the system of Britton by allowing different types of apparatus to receive converted email data.

26.   Beer teaches the relationship between an email address and an URL, and converting between the email address and the URL (Col 4, lines 10-30).

27.   Even though Beer does not specifically teach of converting URL data to an e-mail address, Beer teaches of converting an email address to a URL. It would have been obvious to one of ordinary skill in the art to use Beer's teachings to create a method of converting an URL into an email address by merely reversing Beer's process since senders in Britton's system transmit information through web pages. Doing so would improve the system of Britton and Toyota by allowing users, e.g. patients, to transmit

personal web pages containing HTML data to the receivers, and providing an identifier for the transmission of the email.

28.   As per claim 10, Britton does not teach the communication control apparatus according to claim 9, wherein the controller converts the URL data to the e-mail address of the receiving Internet facsimile apparatus by deleting a HTTP:// in the received URL and converting a dot in the received URL into an @ mark. Beer teaches the relationship between an email address and an URL and teaches of converting the between the two formats, where the "@" is replaced with a dot and HTTP:// is added to the beginning of the converted email address (Col 4, lines 10-30).

29.   Even though Beer does not specifically teach of converting URL data to an e-mail address by deleting a HTTP:// in the received URL and converting a dot in the received URL into an @ mark, Beer does teach of converting an email address to an URL by adding HTTP:// to the email address and converting the "@" into a dot. It would have been obvious to one of ordinary skill in the art at the time the invention was made to user Beer's teachings to create a method to convert URL into an email address by reversing Beer's process. To convert an URL into an email address by deleting HTTP:// in the URL and converting the dot into an "@" would improve the teachings of Britton by specifying the process of conversion to allow the email data to be transmitted through the SMTP, and the conversion would allow apparatuses with SMTP based applications to receive the email.

Conclusion

30.   A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.
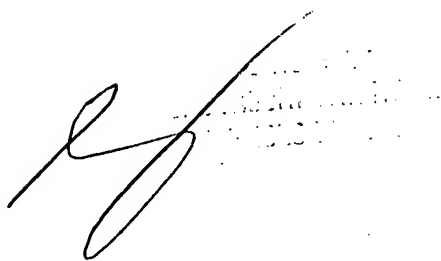
31.   Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be

reached on Monday to Thursday 8AM to 5PM and every other Friday.

32.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this

application or proceeding is assigned is 571-273-8300.

33.   Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be obtained

from either Private PAIR or Public PAIR. Status information for unpublished applications is available

through Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

November 20, 2006
JJ